

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Our Case No. 14829US02)

In the Matter of:)
Jeyhan Karaoguz, et al.)
)
Serial No. 10/672,907)
)
Filed: September 26, 2003)
)
For: THEFT PREVENTION OF MEDIA)
PERIPHERALS IN A MEDIA)
EXCHANGE NETWORK)
)
Examiner: Christopher A. Revak)
)
Group Art Unit: 2131)
)
Confirmation No. 9187)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the final Office Action mailed on January 25, 2006 ("the Final Office Action") with a period of reply through May 25, 2006, pursuant to the attached Petition for One Month Extension of Time. The Applicant also requests review of the arguments stated on pages 2-4 of the Advisory Office Action mailed on May 3, 2006 ("the Advisory Office Action"). No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

REMARKS

The present application includes pending claims 1-21, all of which have been rejected. The Applicants respectfully submit that the claims define patentable subject matter. Claims 1-4 and 7-21 remain rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 6,044,471 (“Colvin”). Claims 5 and 6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Colvin in view of United States Patent No. 5,748,084 (“Ishikoff”). The Applicants respectfully traverse these rejections at least for the reasons previously set forth during prosecution and the following:

I. Colvin Does Not Anticipate Claims 1-4 and 7-21

The Applicants first turn to the rejection of claims 1-4 and 7-21 under 35 U.S.C. 102(b) as being anticipated by Colvin. With regard to the anticipation rejections under 102(b), MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *See* Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted).

With regard to the rejection of independent claim 1 under Colvin, the Applicants submit that Colvin does not disclose or suggest at least the limitation of “registering a communication device deployed at a location that is communicatively coupled to the communication network,” as claimed by the Applicants in claim 1. Referring to Figure 1 of Colvin, Colvin discloses a method and apparatus for protecting software using passwords that are supplied by a password administrator to an end user of the software. *See* Colvin at Abstract. More specifically, Colvin discloses that passwords may be created by a password administrator and the created passwords may be supplied by an authorized representative of the protected software to a potential user of the software. *See* Colvin, column 4, lines 6-32. After the user supplies the authorized representative with registration information, the authorized representative may supply the user with a password that may be used to install the software. *See* Colvin, column 4, lines 33-54. In this regard, **Colvin does not disclose or suggest registering a communication device deployed at a location that is coupled to a communication network.**

Further with regard to the above argument by the Applicants, the Advisory Office Action states the following: “[I]t is disclosed by Colvin of the user registering for use of license software, out of the registration information is information that which is specific to the computing device that which includes an address and other information such as an electronic serial number or motherboard serial number, see column 4, line 55 through column 5, line 6. The information is particular to a computing device and the licensed software will not work on another computer since it has not been previously registered with that device.” *See* the Advisory Office Action, page 2. The Applicants agree that the cited portion of Colvin discloses the use of registration information, which may include “computer-specific registration information.” *See* Colvin, col. 3, lines 2-3. However, the Applicants submit that the **registration information disclosed by Colvin is used only to authorize the use of the software or to provide software updates, and not to register a communication device** (equated by the Final Office Action to a computer) per se, as recited in claim 1 of the present application. *See* Colvin, Figure 1, col. 3, lines 5-13, and

col. 5, lines 6-13. The Applicants submit that the Examiner's statement that "the licensed software will not work on another computer since it has not been previously registered with that device" **relates only to the use of the licensed software on a particular computer and does not have any relation as to whether the computer itself is authorized for use.** In fact, the Applicants submit that a computer, such as the computer 12 of Colvin may be unauthorized to use the software, but it may very well be authorized for another use, such as use with a different software.

In addition, the Applicants submit that Colvin does not disclose or suggest at least the limitation of "receiving validation information relating to the communication device, the validation information entered via the communication device," as claimed by the Applicants in claim 1. Colvin discloses that "the end user must contact the authorized representative for the software, such as password administrator 24, to obtain appropriate authorization code or password as indicated generally by arrows 36." *See Figure 1 of Colvin and col. 4, lines 33-42.* In this regard, **Colvin does not teach receiving validation information relating to the communication device where the validation information is entered via the communication device,** as recited by the Applicants in claim 1.

Further with regard to the above argument by the Applicants, the Advisory Office Action states the following: "Colvin teaches of receiving validation information relating to the communication device, the validation information entered via the communication device, see column 4, line 55 through column 5, line 10." *See the Advisory Office Action, page 3.* The Applicants submit that even though Colvin discloses the use of "computer-specific information," such information is used by Colvin as validation information for purposes of validating the software, and **it is not validation information for validating a communication device,** such as the computer using the software. Therefore, the Applicants submit that Colvin does not disclose receiving validation information relating to the communication device, as recited by the Applicants in claim 1.

Additionally, the Applicants submit that Colvin does not disclose or suggest at least the limitation of "determining whether the communication device is authorized for use in the communication network, based on at least the validation information entered via the communication device," as claimed by the Applicants in independent claim 1. Referring to Figure 1 of Colvin, Colvin discloses that a password or authorization code is required by the software to function properly. *See Colvin, column 4, lines 33-35.* Furthermore, the password administrator obtains registration information from the end user and provides the end user with an appropriate password or authorization code to the software for purposes of installing the software. *See Colvin, column 4, lines 39-42.* **Colvin clearly teaches only determining whether the software is authorized for use, and not whether any communication device is authorized for use.** In this regard, **no validation information is entered via a communication device and no determination is made whether a communication device is authorized for use in the communication network,** as claimed by the Applicants in claim 1. Further in regard to this argument, the Applicants would like to point out that the Advisory Office Action only makes the following statement in rebuttal: "The Examiner respectfully disagrees." Therefore, the Final Office Action and the Advisory Office Action do not provide any further arguments

or citations as to the reasoning of the Examiner's disagreement with the above argument by the Applicants as to the allowability of claim 1.

Therefore, the Applicants submit that claim 1 is allowable. Independent claims 7 and 9 are system claims that contain claim limitations that are analogous to the claim limitations of independent claim 1. Based on at least the foregoing, the Applicants believe the rejection of independent claims 1, 7, and 9 under 35 U.S.C. § 102(b) as being anticipated by Colvin has been overcome and request that the rejection be withdrawn. Additionally, claims 2-6, 8, and 10-14 depend from independent claims 1, 7, and 9, respectively, and are, consequently, also respectfully submitted to be allowable.

With regard to the rejection of independent claim 15 under Colvin, the Applicants submit that Colvin does not disclose or suggest at least the limitation of "a storage device residing in a first home environment," and "a media device residing in a second home environment," as claimed by the Applicants in independent claim 15. Referring to FIG. 1 of Colvin, Colvin discloses a method and apparatus for protecting software using passwords that are supplied by a password administrator to an end user of the software. *See* Colvin, column 4, lines 6-54. In this regard, Colvin does not disclose or suggest a storage device in a first home environment and a media device in a second home environment, as disclosed and claimed by the present invention.

Further in regard to the rejection of claim 15, the Advisory Office Action states the following: "Figure 1 shows computing and storage devices and the media device is interpreted as a computing device, such as a computer." *See* the Advisory Office Action, page 3. Even though the Advisory Office Action interprets the media device as a computing device, such as the computer 12 of Colvin, the Applicants submit that the Final Office Action and the Advisory Office Action do not demonstrate that Colvin teaches "whether to grant access of the media device to the first home environment via the communication network, based on the validation information entered via the media device," as recited by the Applicants in claim 15.

Based on at least the foregoing, the Applicants believe the rejection of independent claim 15 under 35 U.S.C. § 102(b) as being anticipated by Colvin has been overcome and request that the rejection be withdrawn. Additionally, claims 16-21 depend from independent claim 15 and are, consequently, also respectfully submitted to be allowable.

II. The Combination of Colvin and Ishikoff Does Not Render Claims 5 and 6 Unpatentable

The Applicants now turn to the rejection of claims 5 and 6 as being unpatentable over Colvin in view of Ishikoff. Initially, the Applicants submit that claims 5 and 6 depend on allowable claim 1 and are, therefore, also allowable at least for the reasons stated above. The Office Action concedes that "Colvin fails to teach of determining the location of the device and notifying an authority of the location of the communication device if it has been reported stolen." *See* the Office Action, page 6.

In order to overcome this deficiency, the Final Office Action cites Ishikoff at column 1, lines 59-65, which states the following:

When theft of the computer occurs, however, the beacon is activated with a security control program to secure crucial data in the computer's storage, to enable or disable functions of the computer, and to either transmit or destroy or hide sensitive data. The beacon's transmission signal is preferably also trackable to locate and recover the stolen computer.

The Applicants submit that **activating a beacon signal is not equivalent to notifying the authorities**, as claimed by the Applicants in claim 6. Furthermore, Ishikoff defines the purpose of the beacon as to "recover or destroy important data, or to disable the computer." *See* Ishikoff, column 3, lines 46-50.

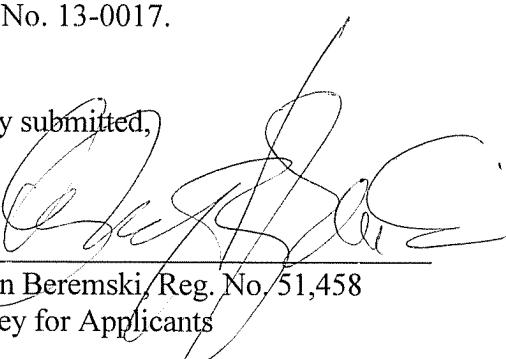
With regard to the above argument on allowability of claims 5 and 6, the Advisory Office Action states that "the applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference." *See* the Advisory Office Action, page 4. The Applicants submit that the above arguments by the Applicants with respect to claims 5 and 6 are sufficiently clear and do not amount to general allegation as they are supported by relevant text citations. The Applicants maintain that Colvin does not disclose or suggest that "activating a beacon" is equivalent to determining a location of the communication device or notifying the authorities, as claimed by the Applicants in claims 5 and 6.

Based on at least the foregoing, the Applicants believe the rejection of claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Colvin in view of Ishikoff has been overcome and request that the rejection be withdrawn.

III. Conclusion

The Applicants respectfully submit that claims 1-21 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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